

REMARKS

This is in response to the Office Action dated October 12, 2010 in which claims 1-20 were pending and rejected. In view of the following, reconsideration and allowance of the application are respectfully requested. All references to the present application are made with respect to the published version at US PAP 2005/0096955.

Claim Rejections- 35 U.S.C. 112

Claims 1-10 and 19-20 were rejected under 35 U.S.C. §112, first paragraph, as allegedly failing to comply with the written description requirement. Applicant respectfully disagrees.

In rejection the claims under §112, first paragraph, the Office Action makes assertions that “[the] Examiner reviewed the specification, and did not find the quoted element.” Applicant respectfully believes that the Examiner is applying an improper standard in rejecting the claims under §112, first paragraph, and that each of the cited elements of the claims are sufficiently supported in the specification such as to reasonably convey to one skilled in the art that the inventor(s), at the time the application was filed, had possession of the claimed invention.

For instance, the Examiner appears to be looking for the words “identification information” in the specification instead of determining whether one skilled in the art would reasonably understand the claimed “identification information” to be supported by the specification. Paragraphs 35, 49, 50, and 52-56 describe an RFQ index 231, which is also illustrated in FIG. 3. It is clearly described that the RFQ index mapping engine indexes, in index 231, RFQ templates generated by manufacturers, under one embodiment. As further described at paragraph 49, engine 232 places an index entry in RFQ index 231 to reflect the RFQ template 312. The specification clearly describes that, in one embodiment, an RFQ template describes the service or goods to be supplied by suppliers (the request for quotation) and that when finalized, the RFQ template is saved and is indexed in the RFQ index mapping which is accessible by suppliers (see e.g., paragraph 7 and 8). One skilled in the art understands that information in the entry in the index identifies (i.e., identification information) the request for quotation that is associated with the entry (see also, FIG. 5B).

Nevertheless, in the spirit of furthering prosecution Applicant has amended independent claim 1 to recite “index information related to the RFQ.” The specification clearly describes that

an RFQ generator engine sends “index information” to an RFQ index mapping builder and that the mapping engine places an index to reflect the RFQ template (see paragraphs 48 and 49).

With respect to item B on page 3 of the Office Action, Applicant respectfully submits that paragraphs 48 and 49 of the specification describe that index information for each entry in the index is provided to the index by an RFQ generator that generated the RFQ. For instance, paragraphs [0048] and [0049] states:

RFQ generator engine 226 automatically sends index information to RFQ index mapping builder 222. This is indicated by block 316. The index information can include a wide variety of different information. For example, in a very simple case, the index information simply indicates that an RFQ is being published by a manufacturer. In that case, the RFQ is simply indexed as a location of the data store from which the entire RFQ template can be retrieved by suppliers. However, in an illustrative embodiment, the index information will at least contain some additional information which can be used to perform preliminary filtering criteria. For example, the index information may include the category and job description from the template, or any other desired information.

Once the index information is received by RFQ indexing mapping engine 232, engine 232 places an index entry in RFQ index 231 to reflect the RFQ template 312 which is being published by the manufacturer 202. This is indicated by block 318.

With respect to item C on page 3, the Office Action alleges that the specification does not support an RFQ template “associated” with a retrieved RFQ. However, the specification clearly describes that an RFQ generator is used to generate and publish RFQ templates for reply by suppliers (see e.g., paragraphs 34, 40). FIG. 5B shows an exemplary template 312 that includes information for an RFQ. As described in paragraph 34, for example, reply engines are used to generate replies to the RFQ templates for requested information. Nevertheless, in the spirit of furthering prosecution Applicant has amended claim 1 to recite “using the processor to generate a reply to the retrieved RFQ by providing information requested in the retrieved RFQ.”

With respect to item D on page 5 of the Office Action, paragraphs 48 and 49 of the specification, for example, describe that an RFQ generator at a requester (see also, FIG. 3) sends or provides index information to the RFQ index mapping builder. As illustrated in FIG. 3, an RFQ generator engine 226 is at a requester (i.e., ACME Bicycle Company 202) which published the RFQ template (i.e., the requester that generated the request for quotation which may be replied to by companies 206 and 208, for example).

Paragraphs [0048] and [0049] states:

RFQ generator engine 226 automatically sends index information to RFQ index mapping builder 222. This is indicated by block 316. The index information can include a wide variety of different information. For example, in a very simple case, the index information simply indicates that an RFQ is being published by a manufacturer. In that case, the RFQ is simply indexed as a location of the data store from which the entire RFQ template can be retrieved by suppliers. However, in an illustrative embodiment, the index information will at least contain some additional information which can be used to perform preliminary filtering criteria. For example, the index information may include the category and job description from the template, or any other desired information.

Once the index information is received by RFQ indexing mapping engine 232, engine 232 places an index entry in RFQ index 231 to reflect the RFQ template 312 which is being published by the manufacturer 202. This is indicated by block 318.

In view of the foregoing, Applicant respectfully submits that the claim language cited in the rejection under 35 U.S.C. §112, first paragraph, complies with the written description requirement and is described in the specification in such a way as to reasonably convey to one skilled in the art that the inventor(s) at the time the application was filed, had possession of claimed invention. It is noted that the above-mentioned amendments to the claims have been made to overcome the Examiner's rejection under §112, first paragraph, and have not been made for reasons of any prior art.

Claim Rejections- 35 U.S.C. 103

Claims 1-6, 8-12, 15, and 19-20 were rejected under 35 U.S.C. §103 as allegedly being unpatentable over Hajmiragha (US Patent No. 6,289,460) in view of Beran et al. (US Publication No. 2002/0055888, hereinafter "Beran"). Claims 13 and 14 were rejected under 35 U.S.C. §103 as allegedly being unpatentable over Hajmiragha in view of Han et al. (US Publication No. 2002/0052807, hereinafter "Han"). Claims 7 and 16-18 were rejected under 35 U.S.C. §103 as allegedly being unpatentable over Hajmiragha in view of Beran, and further in view of Heimermann et al. (U.S. Pat. No. 7,110,976, hereinafter "Heimermann"). Of the rejected claims, claims 1, 11 and 19 are independent claims.

Claim 1

With regard to independent claim 1, the Examiner acknowledged that some of the claimed elements are not found in either of the cited Hajmiragha and Beran references. Specifically, on page 8 of the Office Action, the Examiner acknowledged that neither Hajmiragha nor Beran teach that the RFQ generator is resident at one of the plurality of requesters. Instead, the Examiner alleges:

It would have been obvious to a person having ordinary skill in the art at the time of the invention, to have the generator present at one of the plurality of requesters and to have the RFQ remotely stored, as there are only a limited number of choices at which to place the generator and the data store - either at the requester, at the requestee, or at the third party- since it has been held that rearranging parts of an invention involves only routine skill in the art. *In re Japikse*, 86 USPQ 70.

In making a case for obviousness, the Office has the burden of substantiating evidence to show the requisite motivation exists for the skilled artisan to combine and/or modify the cited references to arrive at the claimed invention. In assessing whether a case has been made, the obviousness rejection must be evaluated in view of the factual inquiries outlined in *Graham v. John Deere*, 148 USPQ 149 (1966):

- (A) Ascertain the scope and content of the prior art;
- (B) Ascertain the differences between the claimed invention and the prior art; and
- (C) Resolve the level of ordinary skill in the pertinent art.

The invention is not obvious unless there was, at the time the invention was conceived, a motivation or reason for a person of ordinary skill and creativity in the art to have combined the elements disclosed or suggested by those references in the way recited in at least the independent claims. Applicant respectfully contends that the proposed reasons to combine and modify the references and preclude patentability provided in the Office Action are without merit. The alleged rationale for the proposed modification has no precedential basis and is not supported by *In re Japikse* cited by the Examiner. MPEP 2144.04 (VI)(C) states, in its entirety:

In re Japikse, 181 F.2d 1019, 86 USPQ 70 (CCPA 1950) (Claims to a hydraulic power press which read on the prior art except with regard to the position of the starting switch were held unpatentable because shifting the position of the starting switch would not have modified the operation of the device.); *In re Kuhle*, 526 F.2d 553, 188 USPQ 7 (CCPA 1975) (the particular placement of a contact in a conductivity measuring device was held to be an obvious matter of design choice). However, "The mere fact that a worker in the art could rearrange the parts of the reference device to meet the terms of the claims on

appeal is not by itself sufficient to support a finding of obviousness. The prior art must provide a motivation or reason for the worker in the art, without the benefit of appellant's specification, to make the necessary changes in the reference device." Ex parte Chicago Rawhide Mfg. Co., 223 USPQ 351, 353 (Bd. Pat. App. & Inter. 1984). (emphasis added)

To the contrary, the Examiner makes bald assertions that the parts of the proposed Hajamiragha/Beran combination could be rearranged (which Applicant does not concede) without providing any motivation or rationale in the prior art to support the alleged modification. Instead, what the Examiner is asserting is tantamount to saying that, while the references do not teach the claimed subject matter, it would be obvious to one of ordinary skill to modify the references to obtain the claimed subject matter. However, Applicant submits that the Examiner is using Applicant's own disclosure to discern the "obviousness" of the claimed subject matter. This, of course, is improper hindsight. (*in re Lee*, 61 USPQ2d 1430 (Fed. Cir. 2002))("It is improper, in determining whether a person of ordinary skill in the art would have been led to this combination of references, simply to '[use] that which the inventor taught against its teacher.'")(quoting *W.L. Gore v. Garlock, Inc.*, 220 USPQ 303, 312-13 (Fed. Cir. 1983)).

Instead, Applicant submits that if it were obvious to change the references as alleged by the Office Action, then the Examiner should be able to point to some suggestion, in the references, to support the modification. Rather than doing that, the Examiner acknowledges that the references fail to teach the elements of the claim, but simply indicates that it would be obvious to one of ordinary skill in the art to modify the references because the parts could perhaps be rearranged. The Examiner has thus failed to make a *prima facie* case of obviousness.

Notwithstanding the Office Action's failure to provide any motivation or rationale for the proposed modification, Applicant contends that the proposed modification of Beran to include an RFQ generator resident at one of a plurality of requesters would render it unsatisfactory for its intended purpose ("If proposed modification would render the prior art invention being modified unsatisfactory for its intended purpose, then there is no suggestion or motivation to make the proposed modification." *In re Gordon*, 733 F.2d 900, 221 USPQ 1125 (Fed. Cir. 1984)(see MPEP 2143.01(V)). Beran explicitly contemplates a centralized commerce system controlled by a single server and database (see summary, paragraphs [0004] and [0005]). It specifically states that user's of its system all access its system and "share central database 110". For instance, at

paragraph 14, Beran specifically states “user’s from multiple agencies 112 and vendors 114 are handled by the commerce system 100 and share the central database 110.” Beran also makes it abundantly clear that the modules of system 100 (used by the agencies) are “within” system 100. That is, they are not resident on any of the agencies or alleged requesters. Instead, they are internal to system 100, and all of these modules read to or write from central database 110. For instance, at paragraph 16, Beran states “FIG. 2 depicts the deferred software modules and their configuration within the Internet commerce system 100. Preferably, each module performs a separate function that writes to or reads from the central database 110 as needed.” Far from teaching or suggesting that any of these modules are resident at a requester, this language all specifically teaches and suggests that the modules are within system 100, and local to database 110. In order to access these modules, Beran makes clear that agencies must log into the system using login module 204 (see paragraph [0018]). This further suggests that all of these modules are within system 100 and local to database 110.

To assert that it would be obvious to a person of ordinary skill in the art to modify Beran to include an RFQ generator resident at one of a plurality of requesters is to ignore the explicit teachings of Beran. It is abundantly clear that Beran itself addresses the issue of providing a system usable by multiple purchasing organizations and multiple vendors (see e.g., paragraphs [0004], [0005], and [0022]-[0026]). The solution provided by Beran is a system controlled by a single server and database where “user’s from multiple agencies 112 and vendors 114 are handled by the commerce system 100 and share the central database 110” (paragraph [0014]) and the modules of the system 100 (used by the agencies) are “within” the system 100. A person of ordinary skill in the art would not read through Beran and be motivated to find a solution to the problem that Beran has just solved, by modifying its teachings as alleged.

At the bottom of page 6 of the Office Action, the Examiner also acknowledged that Hajmiragha does not teach that the RFQ generator that generated the RFQ and stored the RFQ also provides the index information to another data store that is remote from the data store where the RFQ is stored. In order to meet these limitations, the Examiner cited paragraphs 22 and 26 of Beran. Applicant respectfully traverses this rejection as well.

Paragraphs 22 and 26 of Beran make it abundantly clear that the RFQ, and any index to generate an RFQ are all stored in the same data store (central database 110). For instance, even

the paragraphs cited by the Examiner state that the vendors must access system 100 to view the RFQs. Therefore, the RFQs must be stored in central database 110. See paragraph 22, which states "...the vendor access module 214 enables users representing vendors to access the commerce system 100 and view awards that have been made". Thus, since all of the modules in system 100 share central database 110, the RFQs must be stored in central database 110 in system 100. Similarly, paragraph 26 states that system 100 creates index entries according to "the systems internal indexing scheme" and stores them "into its own index...". Since the system uses central database 110, it is also therefore clear that the index to the RFQs is stored in central database 110. Thus, Beran makes it abundantly clear that the RFQs and the index to the RFQs are both stored in central database 110. Thus, even the language cited by the Examiner refutes the assertion that the index to the RFQs is stored in a database separate from the RFQs themselves. Therefore, Applicant submits that Beran does not teach or suggest these elements.

More specifically, independent claim 1 states "wherein the index is stored in a first data store on a remotely located computer storage media, the first data store being remote from the replier,...each of the RFQs being generated by an RFQ generator that is resident at one of a plurality of requesters and each of the RFQs being stored at one of a plurality of data stores remotely located from the first data store...". Because the references fail to teach or suggest these limitations, Applicant submits that independent claim 1 is allowable for this reason as well.

Additionally, Applicant has amended claim 1 to include features previously recited in dependent claim 2. Amended claim 1 recites "using the processor at the replier to identify an RFQ for reply, by filtering entries in the index of RFQs based on supplier filter criteria to create a subset of entries that meet the supplier filter criteria and selecting an entry in the index from the subset of entries." In rejecting claim 2, the Examiner alleges that "it is implied [in Hajamiragha] that an entry is selected from the subset" (emphasis added). Applicant contends that the Examiner has not used the proper test in making a *prima facie* case of obviousness. The test for obviousness is not whether a reference "implies" some claim element, but whether it teaches or suggests that claim element.

The Board of Patent Appeal and Interferences has recently confirmed that a proper obviousness determination requires that an Examiner make "a searching comparison of the claimed invention – *including all its limitations* – with the teaching of the prior art." See *In re*

Wada and Murphy, Appeal 2007-3733, citing *In re Ochiai*, 71 F.3d 1565, 1572 (Fed. Cir. 1995) (emphasis added). Thus, “obviousness requires a suggestion of all limitations in a claim.” *CFMT, Inc. v. Yieldup Intern. Corp.*, 349 F.3d 1333, 1342 (Fed. Cir. 2003) (citing *In re Royka*, 490 F.2d 981, 985 (CCPA 1974)). Moreover, as the Supreme Court recently stated, “*there must be some articulated reasoning with some rational underpinning to support the legal conclusion of obviousness.*” *KSR Int’l v. Teleflex Inc.*, 127 S. Ct. 1727, 1741 (2007) (quoting *In re Kahn*, 441 F.3d 977, 988 (Fed. Cir. 2006) (emphasis added)). It is respectfully submitted that the Office Action fails to show all of the claim elements and therefore fails to establish a *prima facie* case of obviousness.

In view of the above, Applicant respectfully contends that independent claim 1 is neither taught, suggested, nor rendered obvious by the cited references and is in allowable form. Should the Examiner continue to reject the claims using the same references, Applicant respectfully requests that the Examiner make the next action non-final to allow Applicant the opportunity to respond to any alleged rationale or motivation for combining the references that may be set forth by the Examiner.

Claim 11

With regard to independent claim 11, the Examiner cited Hajmiragha as meeting all of the claim limitations except an RFQ template and “entering the job information into a predetermined RFQ template...”. Applicant respectfully traverses the Examiner’s rejection. Hajmiragha teaches a collaborative document which can be checked out and worked on by various users. The cited portion of Hajmiragha states that the document may be an external document that is not within the system of document manager 21 but it can be indexed by document manager 21. Of course, this neither teaches nor suggests that a computer system at a requester that generates and stores an RFQ in a local data store (local to the requester) also sends indexing information for the RFQ to an index remote from the computer system, without prompting from the remote index. In fact, it would appear that Hajmiragha teaches directly the opposite. It appears that the document manager 21 in Hajmiragha performs all of the indexing, itself. Hajmiragha specifically states “a copy of the document is temporarily copied to the document manager 21 during the content indexing process and deleted upon the process completion.” It thus appears that document manager 21 generates its own indexing information

and stores the index local to itself. This is in direct contrast to the claim language of independent claim 11. Thus, Applicant submits that Hajmiragha neither teaches nor suggests the limitations ascribed to it by the Examiner.

In the “Response to Arguments” section on pages 22 and 23, the Office Action states:

[The] Examiner emphasizes that the claim language states that the index is remote from the requester. FIG. 1 of Hajmiragha shows that the Document Manager 21 is remote from the client 22. Hajmiragha states that an external document is indexed and managed by the document manager 21. Since the document is an “external” document, it is understood that the document is saved remotely to the document manager, or local to the requester (in this case, the client computer 22).

These statements disregard the claim language. Claim 11 requires that the RFQ is generated at the requester and saved in a data store local to a computer system at the requester. Hajmiragha does not teach or suggest that the alleged document is generated at the alleged requester (i.e., the client 22). Instead, Hajmiragha indexes the documents in storage 28 that are external to the client 22. The Office Action mischaracterizes Hajmiragha as it does not appear to teach or suggest locally storing the alleged document to client 22.

Additionally, Applicant has also amended claim 11 to include features previously recited in dependent claim 12. Amended claim 11 recites “providing supplier registration information from the requester to a registration component and downloading an RFQ generation engine to the requester” and “after the RFQ generation engine is downloaded to the requester, using the RFQ generation engine at the requester to enter job information into a predetermined RFQ template.” Applicant notes that support for this amendment can also be found at paragraphs [0040]-[0042].

The cited sections of Beran (i.e., paragraphs 16 and 22-26) do not disclose supplier registration information provided from a requester. Further, in alleging that Beran discloses downloading an RFQ generation engine the Office Action appears to reference downloading information in an HTML header page, which does not correspond to a claimed RFQ generation engine.

For at least the above reasons, Applicant respectfully contends that claim 11 is neither taught, suggested, nor rendered obvious by the cited references and is in allowable form.

Claim 19

With respect to independent claim 19, Applicant contends that the cited references do not teach or suggest, either separately or in combination, that indexing information is provided by an RFQ generator at a requester that generated the RFQ. Further, contrary to the assertions in the Office Action, Hajmiragha does not teach or suggest that the alleged document is generated or saved at the alleged requester (i.e., client 22). The Examiner alleges that “it is understood that when creating a document, a user may choose to save it at the client computer”; however, this is not what Hajmiragha teaches and is a bald assertion without any reliance on the disclosure of Hajmiragha. Such features are not disclosed by the references, either separately or in combination.

For at least the above reasons, Applicant respectfully contends that claim 19 is neither taught, suggested, nor rendered obvious by the cited references and is in allowable form.

Claim 13

Claim 13, which was rejected using Hajmiragha and Han, has been re-written in independent form. This amendment to claim 13 does not necessitate a new search. The Office Action acknowledged that Hajmiragha does not teach or suggest an RFQ template or entering job information into a predetermined RFQ template. However, Han also does not teach or suggest these features, and the Office Action has not alleged otherwise. Applicant respectfully contends that independent claim 13 is in allowable form.

Dependent Claims

Applicant contends that related dependent claims 2-10, 14-18, and 20 are also in allowable form at least based on their relation to independent claims 1, 11, 13, and 19, discussed above.

Conclusion

The foregoing remarks are intended to assist the Office in examining the application and in the course of explanation may employ shortened or more specific or variant descriptions of some of the claim language. Such descriptions are not intended to limit the scope of the claims; the actual claim language should be considered in each case. Furthermore, the remarks are not to be considered exhaustive of the facets of the invention, which are rendered patentable, being only example of certain advantageous features and differences, which Applicant's Attorney chooses to

mention at this time. For the foregoing reasons, Applicant reserves the right to submit additional evidence showing the distinction between Applicant's invention to be unobvious in view of the prior art.

Furthermore, in commenting on the references and in order to facilitate a better understanding of the differences that are expressed in the claims, certain details of distinction between the same and the present invention have been mentioned, even though such differences do not appear in all of the claims. It is not intended by mentioning any such unclaimed distinctions to create any implied limitations in the claims.

In view of the foregoing, it is submitted that all pending claims are in condition for allowance. Reconsideration and allowance of the application are respectfully requested.

The Director is authorized to charge any fee deficiency required by this paper or credit any overpayment to Deposit Account No. 23-1123.

Respectfully submitted,

MICROSOFT CORPORATION

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